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**C/M/A # 22940/0002/2581**

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**ATTN: Director of Technology Center 3700**

Serial No.: 09/650,584  
Confirmation No. 8208

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Attorney Docket No.: 22940/2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE****RECEIVED  
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Applicants: Howard N. Straub

Examiner: Vy Q. Bui

APR 28 2005

Serial No.: 09/650,584

Art Unit: 3731

Filed: August 30, 2000

Confirmation No. 9208

For: OPHTHALMIC DEVICE AND METHOD OF MANUFACTURE AND USE

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By: David J. Rikkers

April 28, 2005

Date

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
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ATTN : Director of Technology Center 3700

**PETITION TO WITHDRAW FINALITY OF OFFICE ACTION**

Dear Director of Technology Center 3700:

Applicant hereby requests that the finality of the Office Action mailed December 28, 2004 be withdrawn. Applicant believes that the Office Action was improperly made final, as all of the timely and properly-filed Information Disclosure Statements have not been considered by the Examiner and the references cited therein made of record in this application.

Applicant notes that the first, non-final Office Action, mailed March 1, 2004, indicated that Information Disclosure Statements filed January 24, 2001, April 9, 2001, and May 23, 2002 have not been considered because they are not in the file. Copies of these Information Disclosure Statements

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Attorney Docket No.: 22940/2  
USSN: 09/650,584  
Group Art Unit No.: 3731

were provided again for the Examiner's convenience together with a response to the non-final Office Action on September 1, 2004, along with copies of the references cited therein provided on a CD-ROM. A fourth Information Disclosure Statement, with copies of the references cited therein in paper form, was also filed September 1, 2004.

None of the four 1449 forms were returned with the Final Office Action mailed December 28, 2004. The Final Office Action states that the "IDS in the CD has been ordered to the Examiner location and will be initialized and mailed to the applicant when the CD has been received and reviewed by the Examiner." However, during a February 11, 2005 telephone interview, the Examiner confirmed that the Information Disclosure Statements had not been received or considered by the Examiner. Any delays in filing this petition should not be held against Applicant, as Applicant has attempted to resolve this issue through multiple communications with the Examiner.

As the four Information Disclosure Statements have been properly filed, Applicant submits that it is inappropriate to issue a final Office Action without having considered the Information Disclosure Statements. 37 CFR 1.97 states that:

- (b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:
- (1) Within three months of the filing date of a national application other than a continued prosecution application under § 1.53(d);
  - (2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application;
  - (3) Before the mailing of a first Office action on the merits; or
  - (4) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.
- (c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:
- (1) The statement specified in paragraph (e) of this section; or
  - (2) The fee set forth in § 1.17(p).

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Attorney Docket No.: 22940/2  
USSN: 09/650,584  
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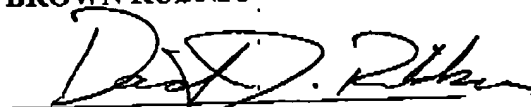
As each of the four Information Disclosure Statements were properly filed under 37 CFR 1.97(b) or (c), Applicant submits that the Office is obligated to consider these Information Disclosure Statements, as the rule states "shall be considered by the Office...." As the Final Office Action serves to close prosecution, Applicant submits that the Office Action mailed December 28, 2004 was improperly made Final.

Applicant notes that because the first three Information Disclosure Statements were filed before the date of the first Office Action on the merits, any new rejection of the claims based on references cited therein would appropriately be a non-final Office Action.

An Amendment and Response is filed on the same date as this petition in response to the Final Office Action in the above-identified application. A petition for a one-month extension through April 28, 2005 is filed with the Amendment and Response. Authorization is hereby given to charge Deposit Account No. 50-0369 in connection with any fees for extension of time or any other fee that may be necessary to permit entry of this petition.

Respectfully submitted,

**BROWN RUDNICK BERLACK ISRAELS LLP**



Date: April 28, 2005

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